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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,376	07/28/2001	Shi-You Ding	NREL 01-36	9956

30955 7590 01/16/2004

LATHROP & GAGE LC
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BOULDER, CO 80301

EXAMINER

SWOPE, SHERIDAN

ART UNIT	PAPER NUMBER
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1652

24

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding..

Office Action Summary

Application No.

09/917,376

Applicant(s)

DING ET AL.

Examiner

Sheridan L. Swope

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1,2,4-12,14,15,28,30-36 and 43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1, 2, 4-12, 14, 15, 28, 30-36, 43 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Applicant's Amendment, on August 5, 2003, Paper No. 20, is acknowledged. It is acknowledged that applicants have abandoned the original filing of this case, filed a Request for Continued Examination, amended Claim 28, and cancelled Claims 3, 13, 16-27, 29, 37-42, and 44-46. Claims 1, 2, 4-12, 14, 15, 28, 30-36, and 43 are hereby analyzed for restriction purposes.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 2, 4-6, 10, 11, 14, 15, 28, 30-36, and 43, in part, and 7, 9, and 12 drawn to AviIII proteins comprising a catalytic domain of GH74 derived from SEQ ID NO: 3 and a CBD derived from SEQ ID NO: 4, classified in class 435, subclass 201.
- II. Claims 1, 2, 4-6, 10, 11, 14, 15, 28, 30-36, and 43, in part, and 8 drawn to AviIII proteins comprising a catalytic domain of GH74 derived from SEQ ID NO: 3 and a CBD derived from SEQ ID NO: 5, classified in class 435, subclass 201.
- III. Claims 28, 30-36, and 43, in part, drawn to any polypeptide comprising SEQ ID NO: 3, classified in class 435, subclass 201.
- IV. Claims 28, 30-36, and 43, in part, drawn to any polypeptide comprising SEQ ID NO: 4, classified in class 530, subclass 324.
- V. Claims 28, 30-36, and 43, in part, drawn to any polypeptide comprising SEQ ID NO: 5, classified in class 530, subclass 324.
- VI. Claims 28, 30-36, and 43, in part, drawn to any polypeptide comprising SEQ ID NO: 4 and SEQ ID NO: 5, classified in class 530, subclass 324.

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VII. Claims 28, 30-36, and 43, in part, drawn to any polypeptide comprising SEQ ID NO: 3, SEQ ID NO: 4, and SEQ ID NO: 5, classified in class 435, subclass 201.

Inventions I-VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, polypeptides of Inventions I-VII are different inventions because they are physically and functionally distinct chemical entities.

Claim 30 and 32 are generic to a plurality of disclosed patentably distinct species comprising the following.

For Inventions I-VII:

- A. 6-His tag;
- B. Thioredoxin;
- C. Hemagglutinin;
- D. Glutathione S-transferase;
- E. OmpA signal sequence tag; and
- F. Leucine zipper.

These species are distinct because fusion proteins containing said tags are common in the art and each tag is a structurally and functionally different moiety.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

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be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art due to their recognized divergent subject matter, as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

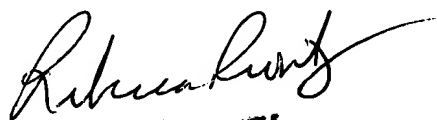
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheridan L. Swope whose telephone number is 703-305-1696. The examiner can normally be reached on M-F; 9:30-6 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Sheridan Lee Swope, Ph.D.


REBECCA E. PROUTY
PRIMARY EXAMINER
GROUP 1000
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